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APPLICATION NO. 12/23/99	FILING DATE 12/23/99	FIRST NAMED INVENTOR TCHAO	ATTORNEY DOCKET NO. R 102-302RE/CO
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IM52/0330

EXAMINER WONG, L
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ART UNIT 1761	PAPER NUMBER 7
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DATE MAILED: 03/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/472,490

Applicant(s)  
Tchao

Examiner  
Leslie Wong

Group Art Unit  
1761



☒ Responsive to communication(s) filed on Dec 1, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-15 and 46-50 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-15 is/are allowed.

☒ Claim(s) 46-48 and 50 is/are rejected.

☒ Claim(s) 49 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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In view of the fact that additional errors in the original patent have been corrected through amendments to the claims, a new/supplemental oath or declaration complying with 37 CFR 1.63 and 1.175 is required.

Claims 1-15 are allowed.

Claim 49 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 46-48 and 50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant does not teach any and all types of non-destructive assays. Only non-destructive chemotaxis assays are contemplated. Applicant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis assays. To make and

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use the invention with non-destructive assays, other than chemotaxis, would involve extensive experimentation.

Applicant does not teach any and all types of inducing agents. Only chemical agents are contemplated. To make and use the invention with an agent other than a chemical agent would involve extensive experimentation.

Claims 46-48 and 50 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application.

The claims have been broadened as Applicant does not teach any and all types of non-destructive assays or any and all types of inducing agents.

Applicant's arguments filed December 1, 2000 have been fully considered but they are not persuasive.

Applicant argues that the invention is not limited to a chemotaxis assay as chemotaxis is the preferred embodiment.

No where in the specification does Applicant contemplate any assay other than a chemotaxis assay. Applicant states on page 2, lines 32-36, that "I have developed a chemotaxis assay procedure", where the entire specification is specifically directed to a chemotaxis assay. Applicant does not consider other non-destructive assays such as stereotaxis, phototaxis,

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electrotaxis, or geotaxis assays. The assays are entirely different and the use of other assays would require extensive experimentation.

All of the claim limitations and arguments have been considered.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 308-1979. The examiner can normally be reached on Tuesday-Friday from 6:30 AM to 5:00 PM.

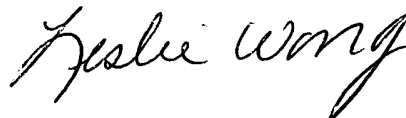
The fax number for this Group is (703) 305-3601.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, reading "Leslie Wong".

**Leslie Wong**  
**Primary Examiner**  
**Art Unit 1761**

LAW  
February 23, 2001